

PATENT  
P-1476-US

**PCT Filed: FEB 2001**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT(S): Michal Linial, Nathan Linial, Nafali Tishby and Golan Yona  
SERIAL NO.: 09/601,278 Examiner:  
FILED: July 31, 2000 Group Art Unit:  
FOR: AN AUTOMATIC METHOD OF CLASSIFYING MOLECULES

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231  
BOX: PCT (EO/US)

ATTN: Office of Initial Patent Examination (OIPE)  
Special Program Law Office

**PETITION UNDER 37 C.F.R. 1.47 (a)**

Dear Sir:

This Petition Under 37 C.F.R. 1.47(a) is being filed in connection with the above-identified Application to join a non-signing jointly named applicant in the subject Application on filing of the attached Declaration and Power of Attorney in compliance with 37 C.F.R. 1.63.

The subject Application U.S. 09/601,278 entered the United States National Stage (EO) under 35 U.S.C. 371 on July 31, 2000 and corresponds to PCT International Application No. PCT/IL99/00057, International Filing Date January 29, 1999 in the name of Yisum Research Development Company of The Hebrew University of Jerusalem as Applicant, and Natan Linial, Michal Linial, Naftali Tishby and Golan Yona as joint inventors. A Notification of Missing Requirements under 35 U.S.C. 371 dated August 22, 2000 was issued by the United States Patent and Trademark Office. A response to the Notification was due September 22, 2000. Applicants are concurrently filing a Petition for A Five-Month Extension Of Time in connection with the subject Application. Therefore, a response to the Notice is due February 22, 2001. Accordingly, this Petition is being timely filed.

In the Communication filed herewith, Applicants have attached the Declaration and Power of Attorney signed by three out of four jointly named inventors, namely and Natan Linial, Michal Linial, and Naftali Tishby. However, the Declaration and Power of Attorney is not signed by Golan Yona, who is one of the jointly named inventors, because Golan Yona after repeated and diligent efforts by the Assignee of interest of the entire right, title, and interest in

Applicant: Haj Yehia  
File No.: P-66769  
Serial No.: 09/381303  
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and to the subject Application, namely Yissum Research Development Company of The Hebrew University of Jerusalem ("Yissum") has refused to sign the Declaration and Power of Attorney.

Therefore, Applicants hereby Petition under 37 C.F.R. 1.47(a) that the subject Application may be made by the other named joint applicants on behalf of themselves and the non-signing named joint applicant.

Under 37 CFR 1.47(a) and M.P.E.P Section 409.03:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in Section 1.17(i) and the last known address of the nonsigning inventor.

Pursuant to 37 CFR 1.47(a) and M.P.E.P Section 409.03(a), attached hereto as Exhibit 3 of the Petition, is a Declaration and Power of Attorney signed by all the available jointly named applicants, namely and Natan Linial, Michal Linial, and Naftali Tishby, on their own behalf as required by 37 CFR 1.63 or 1.175. Pursuant to M.P.E.P Section 409.03(a), the signature block of the non-signing inventor is left blank and thus is to be treated as having been signed by all the available joint named applicants on behalf of the non-signing named applicant.

In the Declaration attached hereto, Renee Ben-Israel, the Intellectual Property Manager of Yissum, demonstrates that diligent efforts were made to obtain the signature of Golan Yona, the named inventor who has refused sign the application papers, on the Declaration and Power of Attorney. Further, pursuant to 37 CFR 1.47(a) and M.P.E.P Section 409.03(d), attached to the Declaration are documents evidencing the diligent, repeated and unsuccessful efforts by Yissum to obtain the signature of the non-signing inventor on the Declaration and Power of Attorney.

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Further, in the Communication, the undersigned authorized the Patent and Trademark Office to charge the fee under 37 C.F.R. 1.17(i) due for filing this Petition under 37 C.F.R. 1.47(a) to Deposit Account 05-0649.

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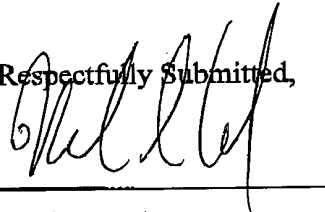
Lastly, pursuant to 37 CFR 1.47(a ) and M.P.E.P Section 409.03(e) the last known address of the nonsigning joint inventor is:

Golan Yona  
Department of Structural Biology  
Stanford University  
Fairchild Science Building D-109  
Stanford, California 94305-5126

Thus, this Petition is in compliance with 37 CFR 1.47(a ) and M.P.E.P Section 409.03. Therefore, Applicants hereby Petition under 37 C.F.R. 1.47(a) that the subject Application may be made by the other named joint applicants on behalf of themselves and the non-signing named joint applicant. Accordingly, Applicants request that the Patent Office grant this Petition and join the non-signing named joint inventor to the subject Application on filing the attached Oath or Declaration in compliance with 37 C.F.R. 1.63.

If any additional fee is due, the undersigned hereby authorizes the Patent and Trademark Office to charge such fee to Deposit Account 05-0649.

Respectfully Submitted,



February 22, 2001

Mark S. Cohen  
Registration No. 42,425  
Attorney for Applicants

Eitan, Pearl, Latzer & Cohen-Zedek  
Crystal Park, Suite 210  
2011 Crystal Drive  
Arlington, VA 22202  
Tel: (703) 486-1177  
Fax: (703) 486-0800

### DECLARATION

I, Renee Ben-Israel, residing at 13/5 Hahayil Street., Jerusalem, Israel 97891, do hereby declare as follows:

1. I am employed in the Intellectual Property Department of the Yissum Research Development Company of The Hebrew University of Jerusalem having a mailing address of P.O.B. 4279, Jerusalem 91042 ("Yissum"). My position is Intellectual Property Manager.
2. I am responsible for the patent administration of all patents and patent applications filed in any jurisdictions through Yissum for The Hebrew University of Jerusalem. My duties include coordinating patent filing and prosecution such as acting as an intermediary between employees of The Hebrew University of Jerusalem who are named inventors on a patent application and the laws firms prosecuting the specific patent application in order to obtain patent related documents necessary for filing or conducting prosecution in the United States Patent and Trademark Office and in other jurisdictions.
3. The subject application U.S 09/601,278 entered the United States National Stage (EO) under 35 U.S.C. 371 on July 31, 2000 and corresponds to PCT International Application No. PCT/IL99/00057, International Filing Date January 29, 1999 entitled "An Automatic Method Of Classifying Molecules", in the name of Yissum Research Development Company of The Hebrew University of Jerusalem as Applicant, and Natan Linial, Michal Linial, Naftali Tishby and Golan Yona as joint inventors for US only (the "PCT Application"). The PCT Application claims the priority of U.S Provisional Application 60/072,977, filed on January 29, 1998. A copy of the cover sheet of the published PCT Application and a copy of the executed Power Of Attorney for the PCT Application are attached hereto as Exhibit 1.
4. As I understand from legal counsel of Yissum, by operation of law in Israel (Israeli Patents Act, 1967) and in accordance with the regulations of The Hebrew University of Jerusalem, in the absence of an agreement to the contrary, an employer shall be the owner of a "service invention", which is an invention developed by an employee: during the period of employment, and as a result of the employment. Golan Yona signed such a statement declaring that the invention is a "Service Invention". Thus,

Yissum is the owner of the entire right, title and interest in and to the subject matter disclosed and claimed in the PCT Application.

5. On August 22, 2000, the United States Patent and Trademark Office issued a Notification of Missing Requirements under 35 U.S.C. 371. A copy of the Notification is attached hereto as Exhibit 2. I understand that the absolute deadline for responding to the Notification is February 22, 2001 with a five-month extension of time. I understand that a Petition for a Five-Month Extension of Time with the required fee is concurrently being filed.
6. I received from the law firm representing Yissum who entered the PCT Application in the United States a letter dated August 8, 2000 reporting the entry into the United States National Stage (EO) under 35 U.S.C. 371 of the PCT Application. The letter included a copy of the PCT Application which was entered in the United States National Stage under 35 U.S.C. 371. Further, I received from the law firm a letter dated August 14, 2000 forwarding the Declaration and Power of Attorney for the subject PCT Application with each of the named inventors listed thereon for signature by the named inventors.
7. In response to the letters dated August 8, 2000 and August 14, 2000, I forwarded to the named inventors Natan Linial, Michal Linial, and Naftali Tishby, who were in Israel at the time, a copy of a Declaration and Power of Attorney requesting that they sign the Declaration and Power of Attorney in connection with the subject Application. On September 17, 2000, Natan Linial, Michal Linial, and Naftali Tishby signed and dated the Declaration and Power of Attorney. A copy of the Declaration signed by Natan Linial, Michal Linial, and Naftali Tishby is attached hereto as Exhibit 3.
8. Since I understood that Golan Yona was going to be in Israel in September 2000, I did not forward the Declaration and Power of Attorney for his signature but rather waited until he arrived in Israel. When he did not arrive in Israel in September 2000, on October 3, 2000, I forwarded to Golan Yona by facsimile a copy of the Declaration and Power of Attorney requesting that he sign the Declaration and Power of Attorney in connection with the subject Application. A copy of the e-mail which was forwarded to Golan Yona requesting his signature on the Declaration and Power of Attorney in connection with the subject Application is attached hereto as Exhibit 4.

9. Between October 3, 2000 and November 2, 2000, I had a telephone conference call with Golan Yona and conducted extensive correspondence by e-mail regarding the signing of the Declaration and Power of Attorney in connection with the subject Application and certain ownership issues asserted by Golan Yona. Attached as Exhibit 5, is a copy of an e-mail dated November 2, 2000 from Golan Yona regarding such issues. Also, attached therewith is my response to the issues Golan Yona raised. As is evident from the e-mail dated November 2, 2000, Golan Yona reviewed the PCT Application.
10. Between November 2000 and December 2000, I made numerous attempts to obtain the signature of Golan Yona on the Declaration and Power of Attorney in connection with the subject Application and to settle the issues Golan Yona raised. These attempts were unsuccessful as Golan Yona never returned the Declaration and Power of Attorney signed.
11. Between October 2000 and February 2001, communications were also conducted through respective legal counsel of Yissum and Golan Yona regarding issues as to ownership of the rights in the PCT Application. Patent legal counsel for Golan Yona have been notified of the date that a response to the Notification is due and also have not responded by providing a signed Declaration and Power of Attorney in view of the deadline.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Renee Ben-Israel

February 22, 2001

Renee Ben-Israel  
Intellectual Property Manager  
Intellectual Property Department  
Yissun Research Development Company  
of the Hebrew University of Jerusalem  
P.O.B. 4279, Jerusalem 91042

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## **EXHIBIT 1**



**PCT**WORLD INTELLECTUAL PROPERTY ORGANIZATION  
International Bureau

## INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

<b>(51) International Patent Classification:</b> <b>G01N</b>	<b>A2</b>	<b>(11) International Publication Number:</b> <b>WO 99/39174</b> <b>(43) International Publication Date:</b> 5 August 1999 (05.08.99)
<b>(21) International Application Number:</b> PCT/IL99/00057 <b>(22) International Filing Date:</b> 29 January 1999 (29.01.99) <b>(30) Priority Data:</b> 60/072,977 29 January 1998 (29.01.98) US <b>(71) Applicant (for all designated States except US):</b> YISSUM RESEARCH DEVELOPMENT COMPANY OF THE HEBREW UNIVERSITY OF JERUSALEM [IL/IL]; Jabotinsky Street 46, 92182 Jerusalem (IL). <b>(72) Inventors; and</b> <b>(75) Inventors/Applicants (for US only):</b> LINIAL, Michal [IL/IL]; Nevo Shaanan Street 18/17, 93707 Jerusalem (IL). LINIAL, Nathan [IL/IL]; Nevo Shaanan Street 18/17, 93707 Jerusalem (IL). TISHBY, Naftali [IL/IL]; Hadliahon Street 6, 96956 Jerusalem (IL). YONA, Golan [IL/IL]; Hivraz Street 3, 76310 Rehovot (IL). <b>(74) Agent:</b> EITAN, PEARL, LATZER & COHEN-ZEDEK; 2 Giv Yam Center, Shenkar Street 7, 46725 Herzlia (IL).		<b>(81) Designated States:</b> AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, CA, CH, CN, CU, CZ, DE, DK, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MD, MG, MK, MN, MW, MX, NO, NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, UA, UG, US, UZ, VN, YU, ZW, ARIPO patent (GH, GM, KE, LS, MW, SD, SZ, UG, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GW, ML, MR, NE, SN, TD, TG). <b>Published</b> Without international search report and to be republished upon receipt of that report.
<b>(54) Title:</b> AN AUTOMATIC METHOD OF CLASSIFYING MOLECULES <b>(57) Abstract</b> <p>The present invention relates to an automatic method of classifying molecules having similar biologic function comprising the steps of: a) creating a hierarchical organization of said molecules in a database, wherein groups of clusters are identified using local consideration resulting in related clusters; b) determining the position of a selected molecule based on the hierarchical organization of step a, whereby selected molecules of similar biologic function are classified.</p>		

OFFICE

## PATENT COOPERATION TREATY

## Appointment of Agent or Common Representative

## POWER OF ATTORNEY

The undersigned applicants:

YISSUM RESEARCH DEVELOPMENT COMPANY OF THE HEBREW  
UNIVERSITY OF JERUSALEM, an Israeli company of 46 Jabotinsky St.,  
Jerusalem 92182

LINIAL Michal, a citizen of Israel residing at  
18/17 Neve Shaanan St., Jerusalem 93707, Israel

LINIAL Nathan, a citizen of Israel residing at  
18/17 Neve Shaanan St., Jerusalem 93707

TISHBY Naftali, a citizen of Israel residing at 6 Hadishon St., Jerusalem  
96956

YONA Golan, a citizen of Israel residing at 3 Haraz St., Rehovot 76310

hereby appoint Messrs:

TALLY EITAN Esq., and/or ZEEV PEARL Esq., and/or DORON LATZER Esq.,  
and/or NACHMAN COHEN-ZEDEK Esq., and/or YITZHAK RAPAPORT Esq.,  
and/or HEIDI M. BRUN, and/or HENRY SINAI, and/or JOEL M. STEIN Esq.,  
and/or SARA JANE GILLIS Esq., and/or ELLEN B. SHANKMAN Esq., and/or  
MATY BARZAM, Esq., and/or TAMAR BEN-PORATH, Esq., and/or IRIS  
PAPPO, Esq., and/or ORA RAPAPORT-IWANIR and/or KALIA KLEIN Esq.,  
and/or LIHU KOLTON, and/or AMIR M. GRUBER Esq., and/or MYLA KAPLAN  
Esq., and/or DANIEL BUSTANAI Esq., and/or YARON LAHNAM

☒ as agents

☐ as common representative

to act on their behalf before the competent International Authorities in  
connection with the international application

Applicant's file reference: P-1476-PC

filed with the Israel Patent and Trademark Office as receiving Office (RO/IL)  
and to make or receive payments on their behalf.

[Signature of the applicant (where there are several applicants, all of them must  
sign)]:

For: **YISSUM RESEARCH DEVELOPMENT COMPANY  
OF THE HEBREW UNIVERSITY OF JERUSALEM**

Signature

Date

MARCH 22, 1999

MORDEHAI PERLMUTER,  
Name and Title of Signatory

MANAGING DIRECTOR & CEO  
Yissum Research Development Co.  
of the Hebrew University of Jerusalem  
P.O.B. 4279, Jerusalem, 91042, ISRAEL

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EITAN PEARL LATZER & COHEN-ZEDEK

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OFFICE

INVENTORS:

Michal Linial

Date

11.2.99

Nathan Linial

Date

11.2.99

Natall Tishby

Date

Golan Yona

Date

16.2.99

All correspondence, notice, official letters and other communications to be directed to:  
Zeev Pearl, EITAN, PEARL, LATZER & COHEN-ZEDEK.  
2 Gav Yam Ct, 7 Shenkar St., Herzlia 46725, P.O. Box 12658, Herzlia 46733, Israel

22.FEB.2001 23:48:06

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EITAN PEARL LATZER COHEN-ZEDEK

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OFFICE

INVENTORS:

Michal Linial

Date

11.2.99

Nathan Linial

Date

11.2.99

Naftali Tishby

Date

11.2.99

Golan Yona

Date

All correspondence, notice, official letters and other communications to be directed to:  
Zeev Pearl, EITAN, PEARL, LATZER & COHEN-ZEDEK,  
2 Gav Yam Ctr, 7 Shenkar St., Herzlia 48725, P.O. Box 12688, Herzlia 46733, Israel

22.FEB.2001 23:48

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**EXHIBIT 2**



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: ASSISTANT COMMISSIONER FOR PATENTS  
Box PCT  
Washington, D.C. 20231

U.S. APPLICATION NO. <b>09/601278</b>	FIRST NAMED APPLICANT <b>LINIAL</b>	ATTY. DOCKET NO. <b>P-1476-US</b>
INTERNATIONAL APPLICATION NO. <b>PCT/IL99/00057</b>		
LA. FILING DATE <b>29 JAN 99</b>	PRIORITY DATE <b>29 JAN 88</b>	
DATE MAILED: <b>22 AUG 2000</b>		

EITAN PEARL LATZER & COHN-ZEDEK  
ONE CRYSTAL PARK SUITE 210  
2011 CRYSTAL DRIVE  
ARLINGTON, VA 22202 3709

**NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

- The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as
  - ☐ a Designated Office (37 CFR 1.494),
  - ☒ an Elected Office (37 CFR 1.495):
    - ☒ U.S. Basic National Fee.
    - ☒ Copy of the international application in:
      - ☐ a non-English language.
      - ☒ English.
    - ☒ Translation of the international application into English.
    - ☐ Oath or Declaration of inventors(s) for DO/EO/US.
    - ☐ Copy of Article 19 amendments.
    - ☐ Translation of Article 19 amendments into English.
    - ☐ The International Preliminary Examination Report in English and its Annexes, if any.
    - ☐ Translation of Annexes to the International Preliminary Examination Report into English.
    - ☐ Preliminary amendment(s) filed \_\_\_\_\_ and \_\_\_\_\_.
    - ☐ Information Disclosure Statement(s) filed \_\_\_\_\_ and \_\_\_\_\_.
    - ☐ Assignment document.
    - ☐ Power of Attorney and/or Change of Address.
    - ☐ Substitute specification filed \_\_\_\_\_.
    - ☐ Verified Statement Claiming Small Entity Status.
    - ☒ Priority Document.
    - ☒ Copy of the International Search Report ☒ and copies of the references cited therein.
    - ☐ Other:
- The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:
  - Translation of the application into English. Note a processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
    - ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
  - Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
  - ☒ Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date.
    - ☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
  - ☒ Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).
- Additional claim fees of \$ \_\_\_\_\_ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due. See attached PTO-875.

**ALL OF THE ITEMS SET FORTH IN 2(a)-2(d) AND 3 ABOVE MUST BE SUBMITTED WITHIN ONE MONTH FROM THE DATE OF THIS NOTICE OR BY ☐ 21 OR ☐ 31 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

- Translation of the Annexes **MUST** be submitted no later than the time period set above or the annexes will be cancelled. Note processing fee will be required if submitted later than 30 months from the priority date.
- ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

**A copy of this notice MUST be returned with this response.**

Enclosed:  
☐ PCT/DO/EO/917  
☐ PTO-875  
☐ Notice of Defective Translation  
 FORM PCT/DO/EO/905 (December 1997)

SHERRY WIGIL, PARALEGAL  
Telephone: 703-305-8853

*SVind*

## **EXHIBIT 3**

**DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below under my name.

I believe that I am the original, first and sole inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled

**AN AUTOMATIC METHOD OF CLASSIFYING MOLECULES**  
the Specification of which

☐ is attached hereto  
☒ was filed on January 29, 1999  
as Application Serial No. PCT/IL99/00057  
and was amended on \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified Specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any provisional application filed in the United States in accordance with 35 U.S.C. §1.119(e), or any application for patent that has been converted to a Provisional Application within one (1) year of its filing date, or any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

**PRIOR FILED APPLICATION(S)**

<u>APPLICATION NUMBER</u>	<u>COUNTRY</u>	<u>(DAY/MONTH/YEAR FILED)</u>	<u>PRIORITY CLAIMED</u>
60/072,977	US	29-Jan-98	YES
PCT/IL99/00057	PCT	29-Jan-99	YES

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application listed below, and, insofar as the subject matter of each of the claims of this application is not disclosed in any prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a), which occurred between the filing date of the prior application and the national or PCT international filing date of this application:



LAW OFFICE

Attorney Docket No.: P-1476-US

APPLICATION  
NO.

PCT/IL99/00057

FILING DATE  
(DAY/MONTH/YEAR)

29-Jan-99

STATUS - PATENTED,  
PENDING, ABANDONED

I hereby appoint as my attorney(s) and agent(s) Heidi M. Brun (Agent, Registration No. 35,104), or Jerome R. Smith, Jr. (Attorney, Registration No. 35,684), or Daniel J. Swirsky (Agent, Registration No. 45, 148) or Mark S. Cohen (Attorney, Registration No. 42, 425) or Rachel L. Abhoudi (Agent, Registration No. 44,490) or Suzanne Erez (Agent, Registration No. P-46,688) said attorney(s) and agent(s) with full power of substitution and revocation to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

Please address all correspondence regarding this application to:

EITAN, PEARL, LATZER, & COHEN-ZEDEK  
ONE CRYSTAL PARK, SUITE 210  
2011 CRYSTAL DRIVE  
ARLINGTON, VA 22202-3709

Direct all telephone calls to (703) 486-0600 and all facsimiles at (703) 486-0800.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

FULL NAME OF INVENTOR: LINIAL, Michal

FULL RESIDENCE ADDRESS: 18 Neve Shaanan Street, Apt. 17,  
Jerusalem 93707, Israel

COUNTRY OF CITIZENSHIP: Israel

FULL POST OFFICE ADDRESS: same

SIGNATURE OF INVENTOR

DATE Sept 17, 2000

LAW OFFICE

Attorney Docket No.: P-1476-US

FULL NAME OF INVENTOR: LINIAL, Nathan  
FULL RESIDENCE ADDRESS: 18 Neve Shaanan Street, Apt. 17  
Jerusalem 93707, Israel  
COUNTRY OF CITIZENSHIP: Israel  
FULL POST OFFICE ADDRESS: same  
SIGNATURE OF INVENTOR Nathan Linial  
DATE Sept. 17, 2000

FULL NAME OF INVENTOR: TISHBY, Naftali  
FULL RESIDENCE ADDRESS: 6 Hadishon Street, Jerusalem 96956, Israel  
COUNTRY OF CITIZENSHIP: Israel  
FULL POST OFFICE ADDRESS: same  
SIGNATURE OF INVENTOR Naftali Tishby  
DATE Sept. 17, 2000

FULL NAME OF INVENTOR: YONA, Golan  
FULL RESIDENCE ADDRESS: 3 Haraz Street, Rehovot 76310, Israel  
COUNTRY OF CITIZENSHIP: Israel  
FULL POST OFFICE ADDRESS: same  
SIGNATURE OF INVENTOR \_\_\_\_\_  
DATE \_\_\_\_\_

22.FEB.2001 23:51

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## **EXHIBIT 4**

**Subject:** [Fwd: Patent status report and docs for signature re Protomap patent]  
**Date:** Tue, 17 Oct 2000 13:30:16 +0200  
**From:** Renee Ben-Israel <renee@yissum.co.il>  
**Organization:** Yissum  
**To:** Golan Yona <golan@gimmel.stanford.edu>

Dear Golan,

I tried calling you yesterday night but was told that you weren't in.  
I'll try again later today.  
Any news with the docs? If you have any question, please let me know.  
Thank you.  
Renee

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Renee Ben-Israel  
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**Subject:** Patent status report and docs for signature re Protomap patent  
**Date:** Tue, 03 Oct 2000 12:20:05 +0200  
**From:** Renee Ben-Israel <renee@yissum.co.il>  
**Organization:** Yissum  
**To:** Golan Yona <golan@gimmel.stanford.edu>  
**CC:** "Linial Michal, Dr." <michall@leonardo.l.s.huji.ac.il>,  
"Linial Natan, Prof." <nati@cs.huji.ac.il>,  
"Tishby Naftali, Prof." <tishby@cs.huji.ac.il>

Dear Golan,

Please accept my apologies for the tardiness of my letter, in fact I understood that you were supposed to be here before Rosh Hashana and therefore didn't send you any papers by mail. Now, I understand that you are scheduled to arrive this week but in order to expedite matters, I'll fax you the documents for your signature as well as the other requested papers.

The docs are the ones related to the US application, namely: Declaration and Power of Attorney and Assignment, please sign with blue ink beside your name, thank you. For your information and this may also be a good opportunity to update Michal, Nati and Taly too in a more detailed way, the patent status of this case is as follows:

Following the first Provisional application filed in January 1998 we have subsequently (January 1999) filed a PCT application designating "all countries". The PCT application was published in August 5, 1999, publication no. WO 99/39174 (a copy of the front page is attached in the fax). The countries designation, in fact, gives you, within 18 months from its filing, the possibility of choice among the "all countries" list, in which countries you really intend to have the patent valid. After long deliberations, we have finally settled for the USA, Europe and Japan considering that these are the most important markets for the technology. The expected actions now are Examination in each of the countries, separately, until the final allowance and granting of the same patents. In the US it may take around a year before we receive a first Office Action, in Europe a bit longer and in Japan we have 7 years before Examination unless we request an Expedite Process.

Apart from that I am attaching to the fax the Hamtsaat Sherut form provided by the inventors prior to the filing and the Horaot Manhala 15-001 as a reference, I think that these are the papers you requested.

Should you have any question, please don't hesitate contacting me.

As for the other issues, I may send it to you in a separate letter, or let's discuss it when you're here.

Best regards and shana tova,

Renee

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## **EXHIBIT 5**

Re:

**Subject: Re:****Date: Tue, 14 Nov 2000 10:25:35 -0800 (PST)****From: Golan Yona <golan@gimmel.stanford.edu>****To: Renee Ben-Israel <renee@yissum.co.il>**

Dear Noemi

Please send documents to that address.  
Golan-----  
Golan YonaDepartment of Structural Biology  
Stanford University  
Fairchild Science Building D-109  
Stanford, California 94305-5126  
U.S.A<http://csb.stanford.edu/golan/>Phone: (650) 725-0754 Fax: (650) 723-8464  
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On Tue, 14 Nov 2000, Renee Ben-Israel wrote:

> Dear Golan,  
 > Please let us have your mailing address, in order to send you a copy of a  
 letter  
 > concerning the prosecution of one of the patent applications.  
 > thank you  
 > Noemi Lerner  
 > Intellectual Property Yissum  
 >  
 > Golan Yona wrote:  
 >  
 > > Dear Renee  
 > >  
 > > We will call you either monday morning, or monday  
 > > afternoon, your time. There is no need for a conference  
 > > call yet. We would like just to clarify few issues.  
 > > When are you available at your office?  
 > >  
 > > Golan  
 > >  
 > > On Thu, 2 Nov 2000, Renee Ben-Israel wrote:  
 > >  
 > > > Dear Golan,  
 > > >  
 > > > I am sorry, I don't think this discussion is leading us anywhere. You  
 > > > certainly have the right to see the facts as you see them and all I can do  
 is  
 > > > to try and explain to you Yissum's procedures vis-a-vis inventors'  
 updating.  
 > > > When we decide to file an application we request a "tofes Hamtsaat Sherut"  
 > > > from the inventors where they disclose, among other details, their  
 invention,  
 > > > funding they may have received, the list of inventors and their  
 proportional  
 > > > rights, personal data as addresses, citizenship, etc. Since the request is  
 > > > usually done by one of the inventors and when all of them belong to the  
 same  
 > > > institution we typically correspond with one inventor only. When the  
 invention  
 > > > is developed by more than one institution we correspond with the other  
 > > > institution, as well, we have an Inter Institutional agreement signed

Re:

between

> > > the parties, etc. Having all parties agreeable, we proceed with the filing.  
 > > > The usual procedure is to send it to a patent attorney to have it drafted  
 in  
 > > > the best possible way in order to provide us with the best and broadest  
 > > > possible patent protection.  
 > > > In the case of this file, since we started with a Provisional filing based  
 on  
 > > > a paper written by 4 persons of the HUJI this wasn't done, we sent the  
 paper  
 > > > to Eitan, Pearl, etc. and after receiving their ok, it was filed "as is" in  
 > > > the US PTO. At this stage you were my "contact person" but some time  
 > > > afterwards you left and I sent the correspondence to Nati.  
 > > > A year later, when we reached the end of the Provisional filing we had to  
 > > > decide on the next steps and since this was considered a good project and  
 we  
 > > > had received funding from the Horowitz fund (I believe you are acquainted  
 with  
 > > > this fact since I can see your signature in the Horowitz fund document  
 letter)  
 > > > we decided to file it in the PCT. At this point, we requested Eitan, Pearl,  
 > > > etc. office to draft the patent as usual (in the best and broadest possible  
 > > > way) and this is exactly what was done and what any sensible patent owner  
 > > > would have done. I have a Power of Attorney form signed by Yisum's CEO  
 and  
 > > > all the inventors (including yourself) in my file. A copy of the PCT  
 > > > publication was sent to Nati in September 1999.  
 > > > The next step was the National Phase (July 2000), here we had to decide in  
 > > > which countries we wanted to keep the application. There were long  
 > > > deliberations since we typically won't incur such expenses without a  
 > > > licensee's support, but we finally decided to file it in the US, Europe and  
 > > > Japan. The decision is Yisum's decision only since this is Yisum's  
 > > > proprietary know-how and the costs are borne by Yisum. We appreciate  
 > > > receiving inventors' feedback but the final decision is Yisum's one.  
 Should  
 > > > we decide to drop the entire portfolio it's our prerogative to do so. What  
 we  
 > > > usually do in these cases is to present the inventors the option of keeping  
 it  
 > > > at their own expense. Since this wasn't the case, you weren't offered this  
 > > > option.  
 > > > As I told you previously, you are certainly entitled to see the facts from  
 > > > your point of view, but from Yisum's standpoint this was a regular  
 procedure.  
 > > > We correspond with one inventor only assuming that the group works  
 together.  
 > > > Should you want to receive information from our office, you are welcome to  
 > > > request it.  
 > > > As for the US and European versions: I haven't yet received them from  
 Eitan,  
 > > > Pearl office but they are both based in the PCT version. I have the  
 Japanese  
 > > > translation if you are interested in it.  
 > > >  
 > > > I hope to have clarified the matter. Should you have any questions, please  
 > > > don't hesitate contacting me. I would also like to suggest a conference  
 call  
 > > > between you, Prof. Levitt, Rachel Bentov, Nati, Tali and me (Michal is away  
 at  
 > > > the moment) in order to overcome the problems. Please let me know what is a  
 > > > suitable time for you. Thank you.  
 > > >  
 > > > Sincerely  
 > > >  
 > > > Renee  
 > > >  
 > > >



Re:

> > >  
> > > Golan Yona wrote;  
> > >  
> > > > Dear Renee  
> > > >  
> > > > I'm Writing you this email in response to repeated claims by you and Nati.  
> > > >  
> > > > It is true that we had a few phone conversations before I left HUJI but  
> > > > our interaction was very limited. I'm puzzled by your/Nati's repeated  
> > > > claims that I have seen the patent application before. The application  
> > > > clearly uses text that I wrote only after I left HUJI. Moreover, part of  
> > > > the text is incorrect and I would have excluded it, had I seen the  
> > > > application before.  
> > > >  
> > > > I'm surprised that Nati, Michal, Tali and Yisum did not check  
> > > > the facts before stating false claims. The FACTS are: (1) a draft of the  
> > > > application was never handed to me. (2) the application uses text that I  
> > > > wrote after I left HUJI. (3) this text was modified by somebody in a way  
> > > > that would not have been approved by me.  
> > > >  
> > > > I think we should move on now.  
> > > >  
> > > > Sincerely,  
> > > > Golan  
> > > >  
> > > > --  
> > > > Renee Ben-Israel  
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